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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,556	06/19/2006	Masaki Iwasaki	292745US0PCT	9861
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
THAKUR, VIREN A				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/583,556

Applicant(s)

IWASAKI ET AL.

Examiner

VIREN THAKUR

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date: 20080107
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-2 and 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As stated in the prior Office Action, mailed November 16, 2007, instant claim 1 recites the limitation wherein the packaged beverage comprises "a green tea extract comprising the following ingredients A, B, and C." The claim is unclear as to whether the percentage of the catechins used is based on the amount of the total beverage or based on the amount of the green tea extract.

The newly added limitation of "wt. % being based on said packaged beverage" is unclear as to whether this refers to the content weight ratio of [(A)/(C)], and as such, the amendment does not overcome the rejection of the limitation discussed above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-2 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohishi et al. (US 20030077347) in view of Tsai et al. (US 4946701) for the reasons given in the prior Office Action, mailed November 16, 2007.**

6. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohishi et al. (US 20030077347) in view of Tsai et al. (US 4946701), as applied to claims 1-2 and 7-11, above, and in further view of Kuznicki et al. (US 5681569), Ekanayake et al. (US H001628 H) and Broz (US 20020197376), for the reasons given in the prior Office Action, mailed November 16, 2007.**

Double Patenting

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7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-2,6-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,3-5 and 8 of copending Application No. 10582873 in view of Tsai et al. (US 4946701) for the reasons given in the prior Office Action, mailed November 16, 2007.

9. Claims 1-2 and 6-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,4-6, 8 and 10 of copending Application No. 10583558 in view of Tsai et al. (US 4946701) for the reasons given in the prior Office Action, mailed November 16, 2007.

10. Claims 1-2, 6-7 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8, 11-16, 18, 21, 25, 26 and 28 of copending Application No. 11258892 for the reasons given in the prior Office Action, mailed November 16, 2007.

11. Claim 8 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8, 11-16, 18, 21, 25, 26 and 28 of copending Application No. 11258892 in view of Ohishi et al. (US 20030077374) for the reasons given in the prior Office Action, mailed November 16, 2007.

Response to Arguments

12. On page 5 of the response, applicants argue that none of the cited references discloses or suggests a composition having the claimed ranges of non-polymer catechins to oxalic acid and non-polymer catechins to caffeine nor the improved storage stability properties resulting therefrom.

This argument has been considered but is not deemed persuasive. Regarding the claimed ratio of oxalic acid to non-polymer catechins, it is noted that Ohishi et al. teach on page 4, claim 9, wherein the beverage further comprises oxalic acid in an amount not greater than the amount of quinic acid. Since the amount of oxalic acid would at most be equal to the amount of quinic acid, the ratio of the oxalic acid to non-

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polymer catechins would have been the same as that of quinic acid, or would have been less than the ratio of quinic acid to non-polymer catechins. Regarding the ratio of non-polymer catechins to caffeine, it is noted that Tsai et al. teach that the ratio of flavanols to caffeine is from 1:1 to 30:1. The ratio 30:1 for instance, falls within the claimed ratio. It is further noted that Tsai et al. define flavanols as catechins. This end point falls within the claimed range and as such, any result obtained from this end point would have been expected to have been inherent in the reference.

13. On page 6, applicants argue that it would not have been obvious to increase the caffeine content to the claimed ratio of 10-10000 since the addition of caffeine would act to reduce the ratio of non-polymer catechins to caffeine.

This argument has been considered but is not persuasive. As discussed above, it is noted that Tsai et al. explicitly teach using a ratio of caffeine to catechins for the purpose of achieving the physiological effects of caffeine. Regarding the suggesting of the improvement of storage stability properties, it is noted that these limitations are not recited in the claims.

14. Applicants' examples and comparative examples have been considered but are not deemed persuasive. It is noted, that the amount of catechins and the pH of the beverages are not the same between example 1 and the comparative example 1, for instance. These two factors would have had an effect on the stability and the color tone and taste of the product, since increased amounts of green tea extract would have had

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an effect on the taste, color and stability. Also, the comparative example 1, for instance, also uses a different tea extract: extract A uses Polyphenon HG, while extract E uses sencha. As such, the data providing unexpected improvement in bitterness, astringency and color tone stability is not convincing.

15. The double patenting rejections have been maintained since, as discussed above, Tsai et al. has been relied on to teach the ratio of catechins to caffeine.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIREN THAKUR whose telephone number is (571)272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571)272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steve Weinstein/
Primary Examiner, Art Unit 1794

/V. T./
Examiner, Art Unit 1794